

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application. No.:	10/616,005	First Named Inventor:	Chip Maxson
Confirmation No.:	1031	Filing Date:	July 8, 2003
Examiner:	Sall, El Hadji Malick	Art Unit:	2157
Docket No.:	0008	Customer No.:	43,699
Assignee:	The Go Daddy Group, Inc.		
Title:	Reseller Program for Registering Domain Names Through Resellers' Web Sites		

REPLY BRIEF (Substitute Replacing Appeal Brief)

Real Party in Interest

The Go Daddy Group, Inc. is the real party in interest.

Related Appeals and Interferences

Patent Application 10/616,195, which shares disclosed subject matter, filing date and real party in interest with the present application, is presently on appeal before the Board. The Appeal Brief for Patent Application 10.616,195 was filed on January 16, 2008.

Status of Claims

Claims 1-20 (all pending claims) stand rejected. The rejection of claims 1-20 is being appealed.

Status of Amendments

All proposed amendments are believed to have been entered.

Summary of Claimed Subject Matter

The subject matter of independent claims 1, 6, 10, and 14 is generally directed towards a reseller program for domain names. The reseller program accepts a plurality of Resellers **400a**, preferably via an Administration Web Site **402**, as members of the reseller program. Each accepted Reseller **400a** (if they wish to actively participate in the program) will have their own reseller web site **400b**. Customers **100** may use the Internet to visit the reseller web site **400b**. The reseller web site **400b** permits the Resellers **400a** to register domain names for their Customers **100**. This is accomplished by the reseller web site **400b** communicating their Customers' **100** orders, preferably via an API connection, to a registrar web site **403** that performs the domain name registration with the assistance of a Registry **102a**. The reseller web site **400b** may collect a fee from their Customers **100** for the domain name registration and forward the fee (or a portion) to the registrar web site **403**.

This approach has the advantage for Resellers **400a** in that it may be practiced so that their Customers **100** do not have to leave the reseller web site **400b** during the process of registering a domain name. Thus, Customers **100** may remain at the reseller web site **400b** where the Customers **100** may possibly make additional purchases from the Reseller **400a** on the reseller web site **400b**.

Independent Claim 1

1. A reseller program utilizing a computer network for allowing a plurality of Customers to register one or more domain names via a registrar web site, comprising: **(See generally the block diagram in Fig. 4 and the flowchart in Fig. 5)**
 - A) means for accepting a plurality of Resellers **400a** into a reseller program, wherein each Reseller **400a** has at least one reseller web site **400b**; **(page 18, line 20 to page 19, line 26)**
 - B) means for creating a registrar web site **403** for registering domain names with an appropriate Registry web site **102b**; **(page 18, line 28 to page 19, line 8; and page 21, line 29 to page 23, line 5)**
 - C) means for allowing a plurality of reseller web sites **400b** to register one or more domain names for one or more customers **100** via the registrar web site **403**; and **(page 18, line 28 to page 19, line 8; and page 22 lines 22-24)**
 - D) means for collecting a fee from each Reseller web site **400b** that registers a domain name for a Customer **100** via the registrar web site **403**. **(page 21 lines 20-28)**

Independent Claim 6

6. A reseller program utilizing a computer network for allowing a plurality of Customers to register one or more domain names via a Registrar, comprising:
 - A) a registrar web site adapted for receiving information from a reseller web site and registering domain names with an appropriate Registry; and **(page 18, line 20 to page 19, line 26)**
 - B) an administration web site adapted for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for the Reseller's Customers. **(page 19, line 9 to page 20, line 2)**

Independent Claim 10

10. A process for allowing a plurality of Customers to register one or more domain names via a reseller program, comprising the steps of:

- A) accepting a plurality of Resellers into a reseller program, wherein each Reseller has at least one Reseller web site; **(page 19, lines 9-26)**
- B) creating a Registrar web site for registering domain names with an appropriate Registry web site; **(page 18, line 28 to page 19, line 8; and page 21, line 29 to page 23, line 5)**
- C) allowing a plurality of Reseller web sites to register one or more domain names for one or more customers via the Registrar web site; and **(page 18, line 28 to page 19, line 8; and page 22 lines 22-24)**
- D) collecting a fee from each Reseller web site that registers a domain name for a Customer via the Registrar web site. **(page 21, lines 20-28)**

Independent Claim 14

14. A process for allowing a plurality of Customers to register one or more domain names via a reseller program, comprising the steps of:

- A) registering a Reseller into a reseller program from an administration web site, wherein the Reseller has a reseller web site; **(page 19, line 9 to page 20, line 2)**
- B) the Reseller customizing an appearance of a registrar web site for the Reseller's Customers from the administration web site; and **(page 21, line 29 to page 22, line 8)**
- C) the registrar web site registering a domain name with an appropriate Registry using information received from the Customer. **(page 18, line 28 to page 19, line 8; and page 22 lines 22-24)**

Grounds of rejection to be reviewed on appeal

Whether claims 1-7 are properly rejected under 35 U.S.C. 101 as being directed towards non-statutory subject matter.

Whether claims 1-17 and 20 are properly rejected under 35 U.S.C. 102(e) as being unpatentable over Bayles U.S. 7,039,697.

Whether claims 18 and 19 are properly rejected under 35 U.S.C. 103(a) as being unpatentable over Bayles U.S. 7,039,697 in view of Vaidyanathan et al. U.S. 2002/0138291.

Argument

CLAIM REJECTION – 35 USC § 101

The OA on page 2, second paragraph from the bottom states that “Claims 1-7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.” The crux of the problem for the Examiner appears to be stated in the last sentence on page 2 which states “Applicant failed to show that the reseller program is ‘embodied in machine readable medium’.”

Applicant respectfully submits that the Examiner has misinterpreted the meaning of the phrase “reseller program”. It appears the Examiner is interpreting a “reseller program” to be a computer or software “program” in requiring Applicant to amend the preamble to claims 1-7 to state in part “a reseller program embodied in a machine readable medium”. While Applicant’s “reseller program” may certainly be automated and many of its steps performed by computer software or programs, the phrase “reseller program” is not intended to refer to a type of computer or software “program”. Specifically, the word “program” is used in the specification and in the claims in the sense of an organized club or group of individuals with a common purpose or goal. In this case, the reseller program’s purpose or goal is to allow Resellers to make money by reselling domain name registrations for a Registrar.

Applicant notes the USPTO often uses the word “program” in a similar manner. See for example the Patent and Trademark Depository Library Program, Disclosure Document Program (discontinued), BPAI Internship/Externship Program for Law Students, Patent Telework Program, etc. While many of these “programs” do use computer or software programs, the names of the programs are not intended to mean that the “programs” themselves are “embodied in machine readable medium.” Applicant’s reseller program falls into the same category.

Applicant’s asserted definition can be seen on page 4 of the specification, lines 24-25 where it states “[t]he first embodiment, which may be referred to as a turnkey reseller program, includes Resellers that are registered into a reseller program.” Page 5 of the specification, lines 9-10 state “[t]he second embodiment also includes Resellers that are registered into a reseller program.” The Examiner’s definition does not work because Resellers are not embodied in machine readable medium and cannot be registered into a computer or software program. However, Applicant’s definition does work because Resellers can be registered into Applicant’s

“reseller program” where the Resellers are part of an organization that has the purpose of reselling domain names.

In addition, all independent claims, *i.e.* 1, 6, 10, and 14, include language that shows Resellers are accepted, entered or registered into a “reseller program.” (Please see claim 1, element A, claim 6, element B, claim 10, element A, and claim 14, element A). From the context of the specification and from all the independent claims, it is clear that “reseller program” is not referring to a computer or software program as the Examiner appears to believe, but instead to a group or club of Resellers that have the purpose of reselling domain names for a Registrar. Thus, Applicant respectfully requests that the Examiner’ 35 USC 101 rejection be dismissed since Applicant’s “reseller program” is not embodied in machine readable medium as the Examiner is asserting.

The Examiner’s Answer on page 9 responded to the above arguments with:

(A) On page 6, Appellant argues with respect to the 35 USC 101 rejection that Examiner has misinterpreted the meaning of the phrase “reseller program.” Appellant argues that the word “program” is used in the specification and in the claims in the sense of an organized club or group of individuals with a common purpose or goal.

In regards to point (A), examiner respectfully disagrees.

“a group of individuals allowing a plurality of customers to register one or more domain names via a registrar web site...” does not fall under a statutory category of invention and is non-statutory subject matter.

The first problem with the Examiner’s Answer is that the Examiner misquoted the preamble of claims 1 and 6 which have both been previously amended to include the words “utilizing a computer network for.” Thus, the Examiner’s quote (created by substituting “a group of individuals” for the claim limitation of “reseller program” and combining that with the rest of the preamble of claims 1 and 6) should have read “a group of individuals utilizing a computer network for allowing a plurality of Customers to register one or more domain names via a registrar web site.”

The second problem with the Examiner’s analysis is that the Examiner only considered the preamble in determining whether the claimed invention is directed towards statutory subject matter. This is in contrast to the guidelines of MPEP 2106 IV (B) first paragraph which states:

To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (*i.e.*, process, machine, manufacture, or composition of matter). (emphasis added)

Thus, since the Examiner has only addressed whether the preamble is statutory subject matter (and has not addressed the claims as a whole) the Examiner's 35 USC 101 rejection is fundamentally flawed and should be reversed. When the claims are considered as a whole, Applicant respectfully submit that they are clearly directed toward statutory subject matter, *i.e.* a machine under the broad definition the courts have been given that term.

CLAIM REJECTIONS – 35 USC § 102

Claims 1-17 and 20 stand rejected under 35 U.S.C. 102(e) as being unpatentable over Bayles (U.S. Patent No. 7,039,697). Applicant respectfully traverses this rejection.

MPEP 2143.03 All Claim Limitations Must Be Taught or Suggested

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

A. The rejection should be withdrawn for claims 1 (and thus claims 2-5) and 10 (and thus claims 11-13). Bayles does not disclose limitation C) of claims 1 and 10.

The Examiner on page 8 of the OA asserts that limitation C) of claim 1 and limitation C) of claim 10 are taught by Bayles at Column 5, lines 29-46. Specifically, the Examiner states:

Column 5, lines 29-46, Bayles discloses any and all domain name retailers, such as existing registrars, can participate much more simply in providing monitor and acquire domain name services. The retailer can still offer such services to its customers under the new model, generally through its Web site (i.e. the same as "allowing a web site or a plurality of web sites to register one or more domain names for one or more customers via the registrar web site")...
(emphasis added)

However, the Examiner misquoted limitation C) in claims 1 and 10 by dropping the word "reseller". The relevant limitations are as follows:

Claim 1, limitation C) states:

C) means for allowing a plurality of **reseller** web sites to register one or more domain names for one or more customers via the registrar web site; and (emphasis added)

Claim 10, limitation C) states:

C) allowing a plurality of **Reseller** web sites to register one or more domain names for one or more customers via the Registrar web site; and (emphasis added)

The dropped “reseller” is important as it distinguishes reseller web sites from a registrar web site. Thus, claims 1 and 10 require “reseller web sites” to register domain names for customers via a “registrar web site.” (Please see the specification on page 18, line 20 to page 19, line 8 and Fig. 4 for further information on reseller web sites 400b and a registrar web site 403.)

The explicitly recited language of claims 1 and 10 stands in contrast to the language quoted by the Examiner from Bayles. Specifically, the Examiner quoted from Bayles “[t]he retailer can still offer such services to its customers under the new model, generally through its Web site.” (emphasis added) However, a retailer offering services to its customers, generally through its Web site (Bayles) does not teach a reseller web site registering domain names for customers via a registrar web site (limitation C) in claims 1 and 10). Simply stated, one web site, i.e. a “[retailer] Web site” (Bayles), does not correspond or teach two web sites, i.e. a “reseller web site” and a “registrar web site” in limitation C) of claim 1 and limitation C) of claim 10.

The Examiner’s Answer on page 9 responded to the above arguments with:

(B) On pages 7-8, Appellant argues that Bayles does not disclose limitation (C) of claims 1 and 10.

In regards to point (B), examiner respectfully disagrees.

Column 5, lines 29-46, Bayles discloses any and all domain name retailers, such as existing registrars, can participate much more simply in providing monitor and acquire domain name services. The retailer can still offer such services to its customers under the new model, generally through its Web site (i.e. the same as “allowing a reseller web site or a plurality of reseller web sites to register one or more domain names for one or more customers via the registrar web site:)... (emphasis added)

The Examiner appears to still believe a “retailer” offering services “through its Web site”, i.e. only one web site is taught in the Examiner’s cite, teaches “reseller web sites to register one or more domain names for one or more customers via the registrar web site”, i.e., two web sites are claimed in limitation C) of claims 1 and 10. Applicant respectfully submits that a retailer Web site (Bayles) does not teach the limitation of a reseller web site and a registrar web site (limitation C) of claims 1 and 10.

However, there is a deeper problem with the Examiner's reading of Bayles onto claims 1 and 10. Specifically, the “[retailer] Web site,” from the Examiner's quote in Bayles does not actually provide the monitor and acquire services and thus does not functionally correspond to “register . . . domain names . . . via the registrar web site” from limitation C) in claim 1 and limitation C) in claim 10. The Examiner relied on column 5, lines 29-46 which states in full:

According to the present invention, any and all domain name retailers, such as existing registrars, can participate much more simply in providing monitor and acquire domain name services. The retailer can still offer such services to its customers under the new model, generally through its Web site. Customers can sign up to have the status of a desired name monitored and the name acquired or re-acquired automatically. The retailer no longer needs to perform the monitoring and acquiring steps itself. Rather, the retailer is acting like a reseller of these services. The services are actually provided by a single (i.e., only one is permitted per registry) intermediary entity or software routine implemented at the registry. The intermediary, or the registry implementing software consistent with the present invention, maintains databases of all domain names for which any "retailer" requests monitoring or acquisition on behalf of its customers; together with information identifying the customer. (emphasis added)

Thus, the Examiner's cite in Bayles (Column 5, lines 29-46) has retailers (such as existing registrars) offering monitor and acquire domain name services to Customers where the “services are actually provided by a single (i.e., only one is permitted per registry) intermediary entity.” However, a “single (i.e., only one is permitted per registry) intermediary entity” also does not disclose a “registrar web site” even though both perform services for customers with a registry.

In order to show why Bayles does not anticipate claims limitation C) of 1 and 10, Application will highlight three different reasons why the claimed “registrar web site” is also not taught by Bayles’ “single (i.e., only one is permitted per registry) intermediary entity.”

First, Bayles itself defines “registrar” in col. 2, lines 64-67 as “[t]he term “registrar” refers to any one of several entities with authority to issue commands or requests to add, edit, or delete registrations to or from the registry for a name space.” Since Bayles (correctly) acknowledges that multiple registrars may exist for a registry, Bayles’ “single (i.e., only one is permitted per registry) intermediary entity” cannot possibly be intended by Bayles to teach the claimed “via the Registrar web site.” In this embodiment, Bayles must be referring to some entity other than a registrar as Bayles requires “only one is permitted per registry” while acknowledging that there may be “several” registrars per registry.

Second, if Bayles intended its “single . . . intermediary entity” to correspond to a “registrar web site”, why not use the term “registrar?” Bayles clearly shows that it is familiar

with registrars and yet defines a new “single . . . intermediary entity” in the paragraph cited by the Examiner that conflicts with Bayles’ own definition of a registrar. Applicant respectfully submits the only logical conclusion is that Bayles is not referring to a “registrar web site” in the Examiner’s cite.

And third, Bayles’ own diagrams illustrate that a registrar is different from, and thus does not correspond to, Bayles’ “single . . . intermediary entity” for monitoring and acquiring domain names. Specifically, Fig. 2 shows REGISTRAR 100 and the Integrated Domain Acquisition System (IDAS) FRONTEND 116 as being different entities. This is further confirmed in Fig. 3 which shows REGISTRAR 100 and the IDAS ACQUISITION ENGINE 118 as also being different entities.

In summation, the question is not whether Bayles discloses a “registrar web site” (which the Examiner appeared to focus on), but whether Bayles discloses all of limitation C) of claim 1 and limitation C) of claim 10. The claim limitation includes more than merely a “registrar web site” and “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Bayles, for all the reasons previously presented, does not disclose “reseller web sites” to register domain names for customers via a “registrar web site” as stated in limitation C) of claim 1 and limitation C) of claim 10.

The Examiner’s Answer on pages 9 and 10 responded to this argument with:

On page 9, Appellant argues that Examiner’s quote in Bayles does not actually provide the monitor and acquire services and thus does not functionally correspond to “registrar . . . domain names . . . via the registrar web site” from limitation C) in claim 1, and limitation C) in claim 10.

In regards to point (C), examiner respectfully disagrees.

Such argued limitation is neither in claims 1 or 10.

The Examiner is correct that limitation C) in claims 1 and 10 does not say “registrar . . . domain names . . . via the registrar web site.” Applicant made a typo in the original Appeal Brief and corrected it above in this Reply Brief to correctly quote the limitation as “register . . . domain names . . . via the registrar web site.” This has no impact on Applicant’s argument.

The Examiner’s catch of this typo does not address Applicant’s point that Bayles’ teaching of a “single . . . intermediary entity” does not correspond to the claim limitation of a “registrar web site” for all the reasons explained above (such as there may be more than one

registrar per registry and thus cannot be a “single (i.e., only one is permitted per registry) intermediary entity”).

B. The rejection should be reversed for claims 6 (and thus claims 7-9) and 14 (and thus claims 15-20). The OA does not point out where in Bayles that claims 6 and 14 are taught.

The Examiner states on page 4 of the OA “[a]s to claims 1, 6, 10 and 14, Bayles teaches a reseller program embodied in a machine readable medium and a process for allowing a plurality of Customers to register one or more domain names via a Registrar web site, comprising . . .” The Examiner continues and addresses the elements of claims 1 and 10, but never addresses the unique elements in claims 6 and 14.

For example, the Examiner never cites where limitation B) in claim 6 or limitation B) in claim 14 are taught in Bayles. Thus, Applicant respectfully requests the reversal of this rejection for claims 6-9 and 14-20.

The Examiner’s Answer on page 10 responded to this argument with:

(D) On page 11, Appellant argues that the OA does not point out where in Bayles that claims 6 and 14 are taught.

In regards to point (D), examiner respectfully disagrees.

Column 5, lines 29-46, Bayles discloses any and all domain name retailers, such as existing registrars, can participate much more simply in providing monitor and acquire domain name services. The retailer can still offer such services to its customers under the new model, generally through its Web site (i.e. the same as “the administrator web site (i.e. “registrar” in Bayles) allowing Resellers to enter the reseller program”). Customers can sign up to have the status of a desired name monitored and the name acquired or re-acquired automatically (i.e. allowing each Reseller to customize the registrar web site for the Reseller’s Customers”). (emphasis added)

Applicant respectfully disagrees with the Examiner that Bayles’ teachings related to monitoring and acquiring domain names corresponds to the claim limitation in claim 6 of “allowing each Reseller to customize the registrar web site for the Reseller’s Customers” and the claim limitation in claim 14 of “the Reseller customizing an appearance of a registrar web site for the Reseller’s Customers from the administration web site.”

The specification (which may be used to shed light on the claims) on pages 21-22 describes the process by which a Reseller may customize an appearance of a registrar web site for the Reseller's Customers as follows:

In order to maintain the appearance of a single web site, i.e. the virtual web site, by the Reseller 400a, graphics and text may be selected by the Reseller 400a to be applied to the registrar web site 403. For example, a custom banner, home page image and footer image may be selected by each Reseller 400a. Unique graphics on a web page will typically enhance the visual appearance of the web page, thereby improving the shopping experience of each Customer 100 and leading the Customers 100 into making more purchases at the registrar web site 403. Resellers 400a may select from default images provided by the administration web site 402, but the Resellers 400a preferably provide their own distinctive graphics. The graphics may have different colors for fonts and background and text for each Reseller 400a. Web pages, as shown in Fig. 44, and Fig. 46 may be used by each Reseller 400a to easily select the desired features for their banner and footer image respectively.

Applicant respectfully submits that the domain name monitor and acquire services from Bayles are vastly different from, and therefore do not teach or suggest, the claim limitation in claim 6 of "allowing each Reseller to customize the registrar web site for the Reseller's Customers" and the claim limitation in claim 14 of "the Reseller customizing an appearance of a registrar web site for the Reseller's Customers from the administration web site." These novel features militate towards reversing this rejection for claims 6 and 14.

CLAIM REJECTIONS – 35 USC § 103

A. The rejection should be reversed for claims 18 and 19. The OA never points out where in Bayles claim 14 is taught and claims 18 and 19 depend on claim 14.

Claims 18 and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bayles in view of Vaidyanathan. Applicant respectfully traverses this rejection.

The OA on page 6 states:

As to claim 18, Bayles teaches the reseller program of claim 14.

The OA on page 7 states:

As to claim 19, Bayles teaches the reseller program of claim 14.

The problem with the Examiner's rejections regarding claims 18 and 19 is that the Examiner has never shown how Bayles teaches claim 14.

37 CFR 1.104 Nature of examination.

(c) Rejection of claims.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis added)

Applicant respectfully requests the dismissal of the rejections for claims 18 and 19 because the Examiner never "designated as nearly as practicable" "the particular part relied on" and never "explained" the "pertinence" of those parts in Bayles as required by 37 CFR 1.104(c)(2).

The Examiner's Answer responded to these arguments by claiming that Bayles discloses claims 6 and 14 in the Examiner's Answer on page 10. However, as Applicant previously stated, the domain name monitor and acquire services from Bayles are vastly different from, and therefore do not teach or suggest, the limitation of a Reseller customizing an appearance of a registrar web site for the Reseller's Customers. Since claim 14 is allowable, the rejection of dependent claims 18 and 19 should be reversed.

B. The rejection for claims 18 and 19 should be reversed. The purpose of Bayles and the purpose of Vaidyanathan are so different that there is no reasonable expectation of success in their combination.

Applicant respectfully submits that there would not have been a reasonable expectation of success in combining Bayles with Vaidyanathan. Bayles teaches a method of integrating a domain name monitoring and acquisition service with a registry (see Bayles' abstract) using a "single (i.e. only one is permitted per registry) intermediary entity."

In contrast, Vaidyanathan teaches a method of making a digital file marketplace accessible by consumers (see Vaidyanathan's abstract).

Thus, Bayles and Vaidyanathan are trying to solve very different problems.

Nevertheless, the OA takes portions of Vaidyanathan related to its Marketplace 10 (which the OA appears to compare with the claimed “administration web site”) and combines it with the teachings of Bayles without explaining how such a combination would be possible. Applicant respectfully submits that there is not a reasonable expectation of success in the combination of Bayles and Vaidyanathan where they have such different purposes.

In the OA on page 8 the Examiner responds to this argument with:

In response to ‘not a reasonable expectation of success in the combination of Bayles and Vaid’, Examiner is pointing out to Appellants that Both [sic] Bayles and Vaid inventions are in the same field of endeavor, and both of them are trying to solve the same invention [sic]. One of ordinary skill in the art would make adjustment to Bayles and Vaid reference to come up with this teaching.

This statement is made without the Examiner ever identifying what the Examiner believes is the “field of endeavor” or what the problem is that “both of them are trying to solve.” Thus, the Examiner has not effectively rebutted Applicant’s assertion that there is not a reasonable expectation of success in the combination where the references are so non-analogous to each other. The Examiner must at least state the field of endeavor and problem they are trying to solve to give Applicant a fair opportunity to respond to the Examiner’s argument.

Applicant respectfully submits that Bayles’ field of endeavor is to integrate a domain name monitoring and acquisition service with a registry (see Bayles’ abstract) using a “single (i.e. only one is permitted per registry) intermediary entity while Vaidyanathan’s field of endeavor is to make a digital file marketplace more accessible to consumers. Thus, not only are their fields of endeavor different, but they are also trying to solve radically different problems. Thus, it would not have been obvious to combine them and there would not have been a reasonable expectation of success in such a combination.

The Examiner's Answer responded to these arguments on pages 10 and 11 with:

In regards to point (F), Examiner respectfully disagrees.

In response to "not a reasonable expectation of success in the combination of Bayles and Vaid", Examiner is pointing out to Appellants that Both [sic] Bayles and Vaid inventions are in the same field of endeavor, and both of them are trying to solve the same invention. One of ordinary skill in the art would make adjustments to Bayles and Vaid reference to come up with this teaching.

Applicant notes that:

- 1) The Examiner still has not identified the field of invention for Bayles and Vaid;
- 2) The Examiner still has not identified what the problem is that "both of them are trying to solve"; and
- 3) The Examiner still has not stated why it would have been obvious to combine Bayles' method of integrating a domain name monitoring and acquisition services with a Registry with Vaid's method of making a digital file marketplace accessible to consumers other than the vague assertion that they are in the same field of invention and "are trying to solve the same invention."

C. The rejection for claim 18 should be reversed. The motivation provided by the Examiner to combine Bayles and Vaidyanathan is defective.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The Examiner on page 7 of the OA states the motivation to combine Bayles and Vaidyanathan to create claim 18 as:

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bayles in view of Vaid to provide the administration web site offering the option to the resellers to receive electronic payments from the registrar based on activities of their associated customers. One would be motivated to do so to allow paperless transaction.

There are three problems with the Examiner's stated motivation of "allow[ing] paperless transaction" for the combination. First, Bayles at Col. 6, lines 32-33 states "[f]ees could be

charged for placing an acquisition request.” Thus, there is no motivation to combine Bayles with an administration web site since Bayles already has a method of collecting fees without the need for an administration web site.

Second, Bayles only shows paperless transactions in its disclosure. Bayles never mentions paper transactions, and thus cannot have mentioned them as a problem. In addition, the Examiner has not shown how an administration web site would make Bayles’ already paperless transactions any more paperless. Thus, there is no motivation to combine Bayles with an administration web site as Bayles already allows paperless transactions.

And third, even if allowing paperless transactions is a valid motivation, there are plenty of ways to do this without incorporating Applicant’s claimed “administration web site.” Thus, the Examiner’s stated motivation does not make Applicant’s “administration web site” obvious because creating an “administration web site” is not an obvious solution for allowing paperless transactions when there are so many other ways to allow paperless transactions (such as allowing Bayles’ retailer web site or single intermediary web site to perform the paperless transactions.)

The Examiner’s Answer on page 11 responded with:

In regards to the point (G), Examiner respectfully disagrees.

In response to applicant’s argument that the motivation provided by the Examiner to combine Bayles and Vaid is defective, and there is no motivation to combine, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. [citations omitted] In this case, One [sic] would be motivated to do so to allow paperless transaction to save time and money.

Applicant notes that the Examiner merely reasserted the Examiner’s previously stated motivation to combine (to allow paperless transaction to save time and money) and did not address any of Applicant’s three reasons stated above as to why that motivation to combine is defective for claim 18.

D. The rejection for claim 19 should be reversed. The motivation provided by the Examiner to combine Bayles and Vaidyanathan is defective.

The Examiner on pages 7 and 8 of the OA states the motivation to combine Bayles and Vaidyanathan to create claim 19 as:

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bayles in view of Vaid to provide the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods. One would be motivated to do so to allow efficient tracking of a reseller commission.

The Examiner's stated motivation of allowing efficient tracking of a reseller commission does not explain why it would be obvious to create the claimed "administration web site" when there are so many other simpler ways for performing the Examiner's stated motivation. For example, it would be much simpler for Bayles' retailer web site or the "single . . . intermediary entity" to keep track of reseller commissions. Thus, the Examiner does not explain why one would be motivated to create an "administration web site" just so that reseller commissions may be efficiently tracked when so many other simpler solutions exist. Stated another way, creating an "administration web site" is not the obvious solution to the Examiner's stated motivation since there are so many simpler ways to achieve the Examiner's stated motivation.

The Examiner's Answer on page 12 responded to these arguments with:

In regards to the point (H), Examiner respectfully disagrees.

In response to applicant's argument that the motivation provided by the Examiner to combine Bayles and Vaid is defective, and there is no motivation to combine, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. [citations omitted] In this case, One [sic] would be motivated to do so to allow efficient tracking of a reseller commission.

Applicant notes that the Examiner merely reasserted the Examiner's previously stated motivation to combine (to allow efficient tracking of a reseller commission), but did not address Applicant's stated reason why that motivation is defective. Specifically, the Examiner did not explain why, of all the simpler ways that exist to allow efficient tracking of a reseller commission, that it would have been obvious to create the claimed "administration web site."

E. The rejection for claim 19 should be reversed. Neither Bayles nor Vaidyanathan disclose the limitation “to display a report showing commission payments during selected time periods” as recited in claim 19.

Claim 19 states:

19. The process of claim 14, wherein the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods.

The Examiner in rejecting claim 19 states:

As to claim 19, Bayles teaches the reseller program of claim 14.

Bayles fails to teach explicitly wherein the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods.

However, Vaid teaches the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods (page 1, [0009]).

The Examiner is using Vaidyanathan (page 1, [0009]) for the limitations of claim 19.

Vaidyanathan at page 1, [0009] states:

[0009] The present invention is a method and system for providing a digital file marketplace, where the digital marketplace includes a plurality of digital files for access by consumers over a network. The method and system include allowing a content owner to post a file on the marketplace for access by users by, providing information about the file, setting a retail price that users will be charged for downloading the file, and setting a reseller commission for the file. A first user may then search for files posted on the digital marketplace for one to resell on a third party website. A second user may further search the files posted on the digital marketplace for one to download. If the second user selects a particular file to download, then the user is charged the retail price set for the file. If the second user downloads the particular file from the third party website, then the first user is paid the reseller commission set for the file. In addition, the content owner is provided with a payment based on the retail price minus the reseller commission.

While paragraph [0009] of Vaidyanathan does mention “a reseller commission,” there are no teachings related to “display[ing] a report showing commission payments during selected time periods” as explicitly recited in claim 19. Thus, the rejection to claim 19 should be reversed for this reason. While the Examiner may have shown “reseller commission,” all words in a claim must be given meaning and the Examiner has not shown all the limitations in claim 19.

The Examiner's Answer on page 12 responds to these arguments with:

In regards to the point (I), Examiner respectfully disagrees.

Paragraph [0009], Vaid discloses . . . if the second user downloads the particular file from the third party website, then the first user is paid the reseller commission set for the file. . . In such disclosure, Vaid teaches explicitly “commission payments” and “the selected time period (i.e. the time the second user downloads the particular file from the third party website). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Bayles in view of Vaid to provide the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods. One would be motivated to do so to allow efficient tracking of a reseller commission. (emphasis added)

The Examiner appears to admit that the limitation “display a report showing commission payments during selected time periods” is not disclosed by Bayles and Vaid by stating it would have been obvious to one of ordinary skill in the art “to modify Bayles in view of Vaid to provide the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods.” Applicant respectfully submits that if you have to modify the prior art to create a claim limitation then the limitation is not disclosed by the prior art by definition. Applicant thus requests the reversal of this rejection.

VI. Conclusion

Applicant respectfully requests an order:

reversing the rejection to claims 1-7 under 35 U.S.C. 101 as being directed towards non-statutory subject matter;

reversing the rejection to claims 1-17 and 20 under 35 U.S.C. 102(e) as being unpatentable over Bayles U.S. 7,039,697; and

reversing the rejection to claims 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over Bayles U.S. 7,039,697 in view of Vaidyanathan et al. U.S. 2002/0138291.

Any questions or suggestions regarding this Appeal Brief should be directed to the undersigned attorneys for Applicant at the telephone number listed below or by email to the email address listed below.

Respectfully submitted,

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Date: 5/15/2008

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Claims appendix

1. A reseller program utilizing a computer network for allowing a plurality of Customers to register one or more domain names via a registrar web site, comprising:
 - A) means for accepting a plurality of Resellers into a reseller program, wherein each Reseller has at least one reseller web site;
 - B) means for creating a registrar web site for registering domain names with an appropriate Registry web site;
 - C) means for allowing a plurality of reseller web sites to register one or more domain names for one or more customers via the registrar web site; and
 - D) means for collecting a fee from each Reseller web site that registers a domain name for a Customer via the registrar web site.
2. The reseller program of claim 1, wherein the reseller web site has the ability to communicate with the registrar web site or the reseller web site includes Internet links to the registrar web site.
3. The reseller program of claim 1, wherein the reseller web sites communicate with the registrar web site via an application program interface protocol.
4. The reseller program of claim 1, wherein the reseller web site includes links to the registrar web site and the registrar web site includes links to the reseller web sites.
5. The reseller program of claim 1, further including means to register domain names via a proxy service, wherein proxy contact information is made publicly available while the Customer receives legal rights in the domain name.

6. A reseller program utilizing a computer network for allowing a plurality of Customers to register one or more domain names via a Registrar, comprising:

- A) a registrar web site adapted for receiving information from a reseller web site and registering domain names with an appropriate Registry; and
- B) an administration web site adapted for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for the Reseller's Customers.

7. The reseller program of claim 6, wherein the registrar web site includes means to register domain names via a proxy service, wherein proxy contact information is made publicly available while the Customer receives legal rights in the domain name.

8. The reseller program of claim 6, wherein the Reseller web sites communicate with the Registrar web site via an application program interface.

9. The reseller program of claim 6, wherein the Reseller web sites communicate with the Registrar web site via an extensible provisional protocol.

10. A process for allowing a plurality of Customers to register one or more domain names via a reseller program, comprising the steps of:

- A) accepting a plurality of Resellers into a reseller program, wherein each Reseller has at least one Reseller web site;
- B) creating a Registrar web site for registering domain names with an appropriate Registry web site;
- C) allowing a plurality of Reseller web sites to register one or more domain names for one or more customers via the Registrar web site; and
- D) collecting a fee from each Reseller web site that registers a domain name for a Customer via the Registrar web site.

11. The process of claim 10, further including the step of registering domain names via a proxy service, wherein proxy contact information is made publicly available while the Customer receives legal rights in the domain name.

12. The process of claim 10, wherein the Reseller web sites communicate with the Registrar web site via an application program interface.

13. The process of claim 10, wherein the Reseller web sites communicate with the Registrar web site via an extensible provisional protocol.

14. A process for allowing a plurality of Customers to register one or more domain names via a reseller program, comprising the steps of:

- A) registering a Reseller into a reseller program from an administration web site, wherein the Reseller has a reseller web site;
- B) the Reseller customizing an appearance of a registrar web site for the Reseller's Customers from the administration web site; and
- C) the registrar web site registering a domain name with an appropriate Registry using information received from the Customer.

15. The process of claim 14, wherein the registering a domain name step includes registering the domain names via a proxy service if desired by the Customer and wherein proxy contact information is made publicly available while the Customer receives legal rights in the domain name.

16. The process of claim 14, wherein the reseller web site communicates with the registrar web site via an application program interface.

17. The process of claim 14, wherein the reseller web site communicates with the Registrar web site via an extensible provisional protocol.

18. The process of claim 14, wherein the administration web site offers the option to the Reseller to receive electronic payments from the Registrar based on activities of the Reseller's Customer.

19. The process of claim 14, wherein the administration web site offers the option to the Reseller to display a report showing commission payments during selected time periods.
20. The process of claim 14, further including the steps of:
the Customer linking from the reseller web site to the registrar web site; and
after registering the domain name, linking from the registrar web site back to the reseller web site.

Evidence appendix

None

Related Proceedings appendix

None